

80 17
E5

~~wherein the sending operation of the second means indicates that the first means has already sent the facsimile data over the first communication network to the recipient, prior to the recipient accessing said second communication network.~~

REMARKS

The above Amendment and following remarks are responsive to the points raised in the final Office Action dated November 19, 2003.

Upon entry of this Amendment, Claims 1-25 are all the claims pending in the application. Claims 1, 12, 18,-20 and 22 will have been amended. No new matter has been introduced by this Amendment. Entry and consideration of this Amendment are respectfully requested.

The Attachment to this Amendment shows the amendments made to claims 1, 12, 18,-20 and 22 by bracketing the text that has been deleted and underlining the text that has been added.

RESPONSE TO THE REJECTION UNDER 35 U.S.C. §§102 & 103

In the Office Action, claims 1-3, 5 and 7-11 stand rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,233,318 to Picard et al. (hereafter Picard). Claims 20-25 stand rejected under 35 U.S.C. §102(e) as being anticipated by Mordowitz et al. (U.S. Patent No. 6,011,794, hereafter Mordowitz). Claims 4 and 6 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Picard and further in view of Cooper et al. (U.S. Patent No. 6,052,442, hereafter Cooper). Claims 12, 13, 18 and 19 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Mordowitz in view of Williams et al. (U.S. Patent No. 6,192,045, hereafter Williams), and further in view of Bloomfield (U.S. Patent No. 6,025,931, hereafter

Bloomfield). Claims 14 and 16 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Mordowitz in view of Williams, further in view of Bloomfield, and further in view of Bobo, II (U.S. Patent No. 5,675,507, hereafter Bobo). Claim 17 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Mordowitz in view of Williams, further in view of Bloomfield, and further in view of Wegner et al. (U. S. Patent No. 5,712,907, hereafter Wegner). Applicant respectfully traverses the rejections for the following reasons.

Claims 1-3, 5, and 7-11

In the Office Action, the Examiner indicates that newly cited reference Picard at Col. 11, lines 43-59 discloses the notification means of the present invention. However, Applicant notes that Picard discloses a IMS that is a kind of server or relay machine. Therefore, the IMS receives messages and then notifies a subscriber that he has messages. On the contrary, the present invention, as recited in claim 1, is directed to a communication apparatus that is a kind of transmitter for sending fax data. So the communication apparatus first sends fax data through internet, and then notifies a recipient that the fax data has been sent to the recipient through internet.

Furthermore, at col. 11, lines 43-59, Picard discloses a notification to alert subscribers of existing messages. The notification uses Access NP with notification capabilities that include, in pertinent part, a message waiting indication (MWI). However, there is no specific disclosure that the MWI notification of Picard is related to a fax that "has been sent" via the Internet, as specifically recited by the claims. Therefore, Picard does not clearly disclose each and every element as set forth in the claims. Accordingly, claims 1-3, 5 and 7-11 are

distinguishable over Picard at least for this reason. Likewise, claims 3, 4, and 6-8 are also distinguishable over Picard based on their dependency from claims 1, 2 and 5, respectively.

Claims 20-25

In the Office Action, the Examiner states that claims 20 and 22 do not specifically recite that a fax "has been sent" as argued in the previous response, but instead recite that a fax is "executed." Claims 20 and 22, as amended, recite that the notification means or step of the present invention notifies a recipient using the PSTN that a facsimile "has been sent" via the Internet prior to the recipient accessing the Internet. Therefore, claims 20 and 22, as amended, are distinguishable over Mordowitz. Likewise, claims 21 and 23-25 are also be distinguishable over Mordowitz based on their dependency from claims 20 and 22.

Claims 4 and 6

Cooper fails to overcome the deficiencies noted above in Picard to render obvious claims 2 and 5. Accordingly, even if one of ordinary skill in the art were to combine the teaching of Picard and Cooper, the combination still would not possess all of the features as recited in claims 2 and 5, from which claims 4 and 6 depend. Accordingly, claims 4 and 6 are believed to be distinguishable over Picard in view of Cooper.

Claims 12, 13, 18, 19

As the same reasons noted above, Picard discloses a IMS that is a kind of server or relay machine. Therefore, the IMS receives messages and then notifies a subscriber that he has messages. On the contrary, the present invention, as recited in claims 12, 18 and 19 is directed to a communication apparatus that is a kind of transmitter for sending fax data. So the

communication apparatus first sends fax data through internet, and then notifies a recipient that the fax data has been sent to the recipient through internet.

Furthermore, as recited in Claims 12, 18, and 19, the notification means of the present invention notifies a recipient that a facsimile communication "has been sent" via the Internet, which is a feature not believed to be taught or suggested by the cited prior art individually or in combination. Therefore, claims 12, 18 and 19 are believed to be distinguishable over the cited prior art. Claims 13-17 are also believed to be distinguishable of the prior art of record based on their dependency from claim 12.

CONCLUSION

In view of the above Amendment and remarks, the Applicant respectfully submits that all the pending claims are patentable over the prior art of record and are now in condition for allowance. Accordingly, the Applicant respectfully requests favorable reconsideration of this case and early issuance of a Notice of Allowance.

AUTHORIZATION


Two checks for \$750.00 and \$410.00 for covering the fees for filing RCE and one-month extension of time, respectively, are attached hereto. The Commissioner is hereby authorized to charge any additional fees which may be required for timely consideration of this Amendment under 37 C.F.R. §§ 1.16 and 1.17, including any extension of time, or credit any overpayment to Deposit Account No. 13-4503, Order No. 1232-4467.

Respectfully submitted,

MORGAN & FINNEGAN, L.L.P.

Date: April 21, 2003

By:



Mark D. Pratt

Reg. No.: 45,794

(202) 857-7887 Telephone

(202) 857-7929 Facsimile

CORRESPONDENCE ADDRESS:

Morgan & Finnegan
345 Park Avenue
New York, NY 10154



Docket Number: 1232-4467
Serial Number: 09/146,069

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of

Takehiro YOSHIDA

Serial No: 09/146,069

Filed : September 2, 1998

For: COMMUNICATION APPARATUS

Group Art Unit: 2622

Examiner: J. Pokrzywa

ATTACHMENT

Commissioner of Patents
Washington, D.C. 20231

SIR,

Please note the following amendments to claims 1, 12, 18-20 and 22:

IN THE CLAIMS

Please note the following changes to claims 1, 12, 18-20 and 22:

1. (Three Times Amended) A communication apparatus comprising:

facsimile communication means for [performing] sending a facsimile to a recipient

[communication] through the Internet by dial-up connection; and

notification means for notifying [a] the recipient using a PSTN that [a] the facsimile has
been sent to the recipient through the Internet, prior to the recipient accessing the Internet.

12. (Three Times Amended) A communication apparatus capable of facsimile
communication through the Internet by dial-up connection, comprising:

Internet communication execution means for establishing a dial-up connection from a station A to an Internet service provider to execute communication with a station B having a TCP/IP address through the Internet; and notification means for calling the station B from the station A, when the dial-up connection is established, notifying the station B via the PSTN that a facsimile [communication] has been [is being] sent through the Internet and description information transmitted through the Internet, prior to the station B accessing the Internet.

18. (Three Times Amended) A control method for a communication apparatus capable of facsimile communication through the Internet by dial-up connection, comprising:

establishing a dial-up connection from a station A to an Internet service provider to execute communication with a station B having a TCP/IP address through the Internet; and

calling the station B from the station A, when the dial-up connection is established, notifying the station B via the PSTN that a facsimile [communication] has been [is being] sent through the Internet and description information of the facsimile sent [communication executed] through the Internet, prior to the station B accessing the Internet.

19. (Three Times Amended) A computer-readable storage medium which stores a program for controlling a communication apparatus capable of facsimile communication through the Internet by dial-up connection, comprising:

a procedure code for establishing a dial-up connection from a station A to an Internet service provider to execute communication with a station B having a TCP/IP address through the

Internet; and

a procedure code for calling the station B from the station A, when the dial-up connection is established, notifying the station B via the PSTN that a facsimile [communication] has been [is being] sent through the Internet and description information of the facsimile [communication executed] sent through the Internet, prior to the station B accessing the Internet.

20. (Four Times Amended) A communication apparatus comprising:
transmission means for transmitting facsimile data via the Internet; and
notification means for notifying a recipient, by a method different from that of the transmission means, that the transmission means has already sent [executed transmission of] the facsimile data to the recipient via the Internet, prior to the recipient accessing the Internet.

22. (Four Times Amended) A communication apparatus comprising:
first means for sending facsimile data over a first communication network to a recipient;
second means for sending data over a second communication network to the [said] recipient;
third means for controlling the first means and the second means;
wherein the third means controls the second means so as to send data corresponding to the sending operation of the first means, and

wherein the sending operation of the second means indicates that the first means has already sent [executed transmission of] the facsimile data over the first communication network to the [said] recipient, prior to the recipient accessing said second communication network.